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REMARKS/ARGUMENTS

Claims 1, 3-5, 7, and 9-11 are pending in this application.

The Examiner rejected claims 1, 3-5, 7, and 9-11 under 35 U.S.C. §103(a) as being unpatentable over Applicants' Prior Art Fig. 4 in view of Koshino (U.S. 4,683,394), and further combined with Takagi et al. (U.S. 5,912,602).

Claim 1 recites:

"A surface acoustic wave device comprising:
first and second longitudinally coupled resonator type surface acoustic wave filters, each of said first and second surface acoustic wave filters having a piezoelectric substrate, at least one interdigital electrode transducer disposed on the piezoelectric substrate, and at least one reflector disposed on the piezoelectric substrate;
a package having the first and second surface acoustic wave filters mounted therein and electrode lands electrically connected to each of the first and second surface acoustic wave filters; and
a plurality of bonding wires electrically connecting each of the first and second the surface acoustic wave filters to the electrode lands of the package; wherein
the bonding wires are arranged so as not to pass over both of the at least one interdigital electrode transducer and the at least one reflector of either of the first and second surface acoustic wave filters;
said at least one interdigital electrode transducer and said at least one reflector of each of the first and second surface acoustic wave filters is made of a metal having a heavier mass than that of aluminum or an alloy including the metal; and
the electrode lands are located outside of an area between the **first and the second longitudinally coupled resonator type surface acoustic wave filters.**" (emphasis added)

Applicants' claim 7 recites features that are similar to the features recited in Applicants' claim 1, including the above-emphasized features.

The Examiner alleged that the combination of AAPA, Koshino and Takagi et al. teaches all of the features recited in Applicants' claims 1 and 7. Particularly, the Examiner alleged that Takagi et al. teaches "placing all bonding pads outside the area between two longitudinally coupled resonators #[1]10, #[1]12, #209-#214." Applicants

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respectfully disagree.

In contrast to the present claimed invention and the Examiner's allegations, Takagi et al. specifically teaches that the surface acoustic wave resonators shown in Figs. 1 and 2 are transversely coupled surface acoustic wave resonators, **NOT longitudinally coupled** surface acoustic wave filters as recited in Applicants' claims 1 and 7.

Takagi et al. fails to teach or suggest that the arrangement of elements, including the arrangement of the electrode pads 110, 112, and 209-214, shown in Figs. 1 and 2 could or should be used in a surface acoustic wave device including longitudinally coupled surface acoustic wave filters. In fact, Takagi et al. specifically discloses that "the transverse elastic coupling of the plurality of surface acoustic wave resonators is performed in such a way that the plurality of surface acoustic wave resonators compose a single coupling (or synthetic) resonator."

Thus, if the arrangement of elements of Takagi et al. were modified to include two longitudinally coupled surface acoustic wave filters, the modified device would be unsatisfactory for its intended purpose, i.e., to obtain a single coupling (or synthetic) resonator from the transverse elastic coupling of the plurality of surface acoustic wave resonators. The Examiner is reminded that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and MPEP § 2143.01.

Therefore, Applicants respectfully submit that none of AAPA, Koshino and Takagi et al. teaches or suggests the features of "first and second longitudinally coupled resonator type surface acoustic wave filters" and "the electrode lands are located outside of an area between the first and the second longitudinally coupled resonator type surface acoustic wave filters" as recited in Applicants' claims 1 and 7.

Furthermore, Takagi et al. fails to teach or suggest any advantages or benefits that are obtained by the specific locations of the electrode pads 110, 112, and 209-214.

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In fact, Takagi et al. fails to teach or suggest anything at all about the specific locations of the electrode pads. Thus, Applicants respectfully submit that there would have been absolutely no motivation to modify the device of AAPA to include electrode pads that are located in the manner shown in Figs. 1 and 2 of Takagi et al. The Examiner is reminded that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987).

At best, the Examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at Applicant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. That which is within the capabilities of one skilled in the art is not synonymous with obviousness. See Ex Parte Levengood, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). As noted above, the prior art clearly teaches away from the combination proposed by the Examiner, instead of suggesting the combination.

Instead of basing the conclusion of obviousness on actual teachings or suggestions of the prior art and the knowledge of one of ordinary skill in the art at the time the invention was made, the Examiner has improperly used Applicants' own invention as a guide. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Federal Circuit has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

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Accordingly, Applicants respectfully submit that AAPA, Koshino and Takagi et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in Applicants' claims 1 and 7.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Prior Art Fig. 4 in view of Koshino and Takagi et al.

In view of the foregoing remarks, Applicants respectfully submit that claims 1 and 7 are allowable. Claims 3-5 and 9-11 depend upon claims 1 and 7, and are therefore allowable for at least the reasons that claims 1 and 7 are allowable.

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: February 23, 2005


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